REMARKS

The present request for reconsideration does not require the payment of any additional fees. Nevertheless, authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. RESPONSE TO THE REJECTION OF CLAIMS 14-35

The Examiner rejected claims 14-28 and 32-35 as anticipated under 35 U.S.C. § 102 in view of U.S. Patent Application Publication No. 2003/0236916 to Adcox et al. in the Office Action dated February 2, 2010 (hereafter "Office Action"). Claims 29-31 were rejected as obvious in view of Adcox et al. (Office Action, at 27).

A. Burden of Proving Anticipation Under 35 U.S.C. § 102

"In order to demonstrate anticipation, the proponent must show that the four corners of a single, prior art document describe every element of the claimed invention." *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 88 U.S.P.Q.2d 1751, 1758, 2008 WL 4614511, *8 (Fed. Cir. 2008). The prior art reference relied upon to show anticipation "must not only disclose all elements of the claim within the four corners of the document, but also disclose those elements arranged as in the claim." *Id.* "As arranged in the claim means that a reference that discloses all of the claimed ingredients, but not in the order claimed, would not anticipate because the reference would be missing any disclosure of the limitations of the claimed invention arranged as in the claim." *Id.* "The test is thus more accurately understood to mean arranged or combined in the same way as in the claim." *Id.*

B. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"**All words in a claim must be considered in judging the patentability of that claim against the prior art.**" MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight.**" MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of**

obviousness." MPEP § 2143.01 (citing *KSR*, 550 U.S. at 14, 82 U.S.P.Q.2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge,* 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

C. Adcox et al. Is Not Prior Art

The Adcox et al. reference was filed on April 21, 2003. This filing date is after the priority date of the present application, which is September 25, 2002.

The Adcox et al. claims priority to a provisional patent application no. 60/374,690. A copy of this provisional patent application is attached. That application contains two pages of text and includes a 57 page document describing a prior art system. That document appears to be a previously filed patent application that lists five different inventors (none of which are Mr. Adcox) and does not disclose the invention nor provide any drawings for the invention identified in the specification of the provisional application.

For the Examiner's reference, a copy of the provisional patent application no. 60/374,690 is provided herewith. Of course, the Examiner may also access the contents of this application electronically as well.

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application **with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.**" MPEP § 2136.03 (emphasis added); *see also* MPEP § 706.02(f)(1).

The text cited by the Examiner in the cited published patent application of Adcock et al. is not accorded the filing date of the provisional patent application from which it claims priority. All the paragraphs relied upon by the Examiner as teaching or suggesting a claimed limitation are not present in the provisional application no. 60/374,690. For example, Adcox et al. disclose a OEC. The OEC has a MAC address and alters a serial portion to point to the OEC host table entry for the source MAC address. There is no disclosure of any OEC that is connected to a first network element and sets up any connection between a first network element and an external device. Nor is there any teaching or suggestion of any device that establishes a temporarily transparent connection between the first network element and the external device. Nor is there a disclosure of any unique address of the first network element that is valid for the external device being transferred to the external device. Indeed, the provisional application does not teach or suggest any transfer of any unique address from a network element to an external device. The provisional application merely suggests that headers in messages should be translated.

The provisional application only names one inventor, Timothy Adcox, but the Adcox et al. reference names multiple inventors. The naming of additional inventors indicates that new matter contributed by the additional inventors is present in the cited published application that is not in the provisional application.

D. Claims 14-27, 32 And 34 Are Allowable

Claim 14 requires a network node device to utilize a method that sets up a connection between a first network element and an external device. The connection is set up such that the unique address of the first network element is converted to an address valid for the external device. If the network node device determines that a message header entry characterize an expanded packet-oriented protocol, it establishes a temporarily transparent connection between the first network element and the external device. The unique address of the first network element that is valid for the external device is transferred to the external device without converting that address for the duration of the temporarily transparent connection. Claims 15-27, 32 and 34 depend directly or indirectly from claim 14 and also contain these limitations.

Even if Adcox et al. is improperly applied as prior art, Adcox et al. do not render claims 15-27, 32 or 34 unpatentable. Adcox et al. disclose a MAC layer translation system that has a home network unit coupled to a passive optical network. Upon receiving an outgoing transmission from a host system that includes a host MAC layer address, the home network unit accesses a MAC address table to determine a secondary MAC layer address associated with the host MAC layer address and modifies the outgoing transmission to replace the host MAC layer address with the secondary MAC layer address. (Adcox et al., Abstract).

Adcox et al. do not teach or suggest any unique address of the first network element that is valid for the external device being transferred to the external device without converting that address for the duration of the temporarily transparent connection. To the contrary, Adcox et al. teach that all outgoing messages to external devices are replaced with a different address. (Abstract; *see also* ¶¶ 118-19).

E. Claims 28-31, 33 And 35 Are Allowable Over Adcox et al.

Claim 28 requires a network node element for supporting a transparent exchange of data packets to include at least one first network interface configured to connect to a packet-oriented network, at least one second network interface configured to connect to an external device, and at least one monitoring unit operatively connected to at least one of the at least one first network interface and the at least one second network interface. The at least one monitoring unit is configured to establish a temporarily transparent connection between at least one network element of the packet-oriented network and the external device. The network node element is also configured to not convert a unique address of any network element that is allocated to that network element by the external device for a duration of a temporarily transparent connection established between that network element and the external device. Claims 29-31, 33 and 35 depend directly or indirectly from claim 28 and also contain these limitations.

As discussed above, even if the Adcox et al. reference is improperly applied as prior art by the Examiner, there is no teaching or suggestion of any network node element configured to not convert a unique address of any network element that is allocated to that network element by the external device for a duration of a temporarily transparent connection established between

that network element and the external device. In fact, Adcox et al. teaches away from such a limitation. (Abstract; ¶¶ 118-119).

F. EP Patent No. 1 543 670 B1 Shows The Pending Claims Are Allowable

The present application corresponds to granted European Patent No. EP 1 543 670 B1. For the Examiner's reference, a copy of this patent is provided with the Amendment dated October 8, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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